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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/112,131 07/08/98 WALKER

J WD2-96-002X1

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LM12/0511

EXAMINER

NGUYEN, C

ART UNIT

PAPER NUMBER

2764

DATE MAILED:

05/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/112,131

Applicant(s)

Walker et al.

Examiner
Cuong H. Nguyen

Group Art Unit
2764



☒ Responsive to communication(s) filed on Feb 7, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1, 67, 113, and 177-192 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 67, 113, and 177-192 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 17

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. This Office Action is the answer to the communications received on 2/07/2000 (the amendment); which paper has been placed of record in the file.
2. Claims 1, 67, 113, 177-192 are pending in this application.

Response

3. Due to the amendment, previous rejections on 35 U.S.C. 112, 2nd para. are withdrawn, the examiner submits that new ground of rejections based on 35 U.S.C. 103(a) are made. Hence, the arguments are moot. The examiner submits the followings as basis for examination this application.

MPEP 2113 Product-by-Process Claims [R-1]

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not

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differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)

About structural limitations in method claims: When considering a method claim, patentable weight is given to the structure on which the claimed process is carried out in determining the obviousness of that process; *In re Kuehl*, 177 USPQ 250 (CCPA 1973); and to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure, *ex parte Pfeiffer*, 1962 C.D. 408 (1961).

4. The following rejections are based on the examiner's broadest reasonable interpretation of the claims, *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Claim Rejections - 35 USC § 103

5. Claims 1, 67, 113, 177, 178, and 179-192 are rejected under 35 U.S.C. § 103 as being unpatentable over Harte (US Pat. 4,576,579), in view of the Official Notice.

A. Referring to claims 191-192: These claims contain the most similar limitations in claims 1, 67, 113, 177, 178, and 179-190;

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therefore it is analyzed and the results would be applied for these claims because of similarity. The "product-by-process claim" format in claims 191-192 are merely a well-known concept that are widely used at least in ability/admission testing for jobs, for class placement in schools.

Harte provides students with immediate feedback as to the correctness of their responses by using a template (for scoring). He discloses that this electric circuit that indicate to the student when he has made a correct or incorrect selection (see **Hart**, the abstract).

Hart fails to disclose exactly a similar application using his concept as claimed by the applicants.

However, the Official Notice is taken here that all the claimed limitations are well-known at least in the above field. For example, a controller unit for receiving a request to grade a multiple choice test, it would define a testing level and selecting an appropriate test level questions (a requested expert qualification), this controller unit (computer using for testing) having a database for storing a plurality of test levels/(expert qualifications), each stored level/(expert qualification) corresponding to an appropriate test/(expert of a plurality of experts), each stored test answer template/(expert qualification) being associated with an address stored in the database and

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corresponding to a test/an expert. Then, these means are obviously involved in this test:

- means for selecting/searching the database to identify a test/expert corresponding to the requested test/qualification and an address corresponding to the identified test;

- means for authenticating data (e.g. tester I.D., picture I.D., authorized personnel in a test room .etc.);

- means for guaranteeing payment to the selected test;

- means for initiating remittance of payment to a test;

- means for selecting the end user requests for test evaluation;

- means for transmitting a portion of test result to the address corresponding to an identified result template (for scoring);

- means for receiving a test answer/result in response to the end user request;

- means for transmitting test answers to the end user;

In other words, these limitations can be done exactly by a computer system from a testing lab.

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the same concept of testing a level/(an achievement) to perform functions as claimed; because it suggests using a similar means and applying a similar

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concept as a expert matching computer to select an appropriate source for a specific solution.

B. Referring to claims 1, 67, 113, 177-185: The limitations of these claims recite the same claim limitations as claims 191-192 discussed above. The same analysis and reasoning set forth above in the rejection for obviousness of claims 191-192 applied to these claims also because they are just computer and method claims for the above device; moreover these claims may have more broader limitations.

Conclusion

6. Claims 1, 67, 113, 177-179, 181, 183, 185, 187-189 are rejected.

7. The attached references are considered pertinent to applicant's disclosure.

- Dyson, "Information, bid and asked", Forbes, v146, n4, p92(1), 8/20/1990.

- Blanco, "Electronic markets bring it all home", Corporate Computing, v1, n2, p201(2), August 1992.

- Wong et al., "AMIX announces market-building phase; world's first online information marketplace stocks shelves.", Business Wire (San Francisco, CA, US), pp.1-2, 3/17/1992.

- Padgett, "Information marketplace stocks "shelves" for mid-June debut: the new service will be a meeting place for buyers and

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sellers (Introduction of American Information Exchange Corp.),
Link-Up, v9, n3, p1(2), June 1992.

- Wright, "High-tech juice keeps electronic emporiums humming",
Computerworld, v.26, n.41, pp.1-3, 10/12/1992.

- John Walker, "MicroTimes",

http://www.fourmilab.ch/autofile/www/chapter2_101.html, pp.1-23,
3/26/1992.

- Farmer et al., "From habitat to global cyberspace",

<http://www.communities.com/paper/hab2cybr.html>, pp.1-9.

- Orr, "Join the Information Economy", Computer-Aided
Engineering, April 1992.

- Nishimura et al., (US Pat.4,789,929) about a CT system for
spirally scanning subject on a movable bed synchronized to x-ray
tube revolution.

- Harte, (US Pat. 4,576,579) about instructional and testing
apparatus with switch closure at two different depths.

8. Any inquiry concerning this communication or earlier
communications from the examiner should be directed to examiner
Cuong H. Nguyen, whose telephone number is (703)305-4553. The
examiner can normally be reached on Monday-Friday from 7-4:30.

If attempts to reach the examiner by telephone are
unsuccessful, the examiner's supervisor, James P. Trammell, can
be reached on (703)305-9768.

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Any response to this action should be mailed to:

Box Issue Fee

Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2700

Washington, D.C. 20231

or faxed to: (703) 308-9051, (for formal communications)

Or: (703) 305-0040/308-1396 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.-

Cuong H. Nguyen
May 05 2000

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cuonghuyen